



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/191,997	11/13/98	EDWARDS	J GENSET016A
------------	----------	---------	--------------

020995 HM12/0508
KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

EXAMINER

HARA, E

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 05/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/191,997

Applicant(s)
Dumas Mline Edwards et al.

Examiner
Eileen B. O'Hara

Group Art Unit
1646



☒ Responsive to communication(s) filed on March 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-18 is/are pending in the applicat

Of the above, claim(s) 9-12, 15, and 17 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-8, 13, 14, 16, and 18 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1646

DETAILED ACTION

1. Claims 1-18 are pending in the instant application. Claims 1-8, 13 and 18 have been amended as requested by Applicant in Paper Number 8, filed March 13, 2000.
2. Applicant's election without traverse of Group I in Paper No. 8 is acknowledged. Within Group I, claims 1-8, 13, 14, 16 and 18, Applicants selected the sequences of SEQ ID NOS: 136, 138, 139, 146, 150, 154, 156, 157, 167 and 169 for examination. However, upon further consideration, because the claims are directed to nucleic acids encoding polypeptides, further restriction is needed.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
Applicant is advised that claims 1-8, 13 and 18 are improper Markush claims because the ten elements recited therein are nucleic acids encoding polypeptides which do not serve common functions which are based upon a common property or special technical feature not found in the prior art. These nucleic acids are independent **and** distinct chemical compounds lacking either a common structural property which distinguishes them as a group from structurally related compounds of the prior art or which provides them with a common utility which is lacking from those prior art nucleic acids encoding proteins.

Therefore, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 136 encoding the polypeptide of SEQ ID NO: 89,

Art Unit: 1646

diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.

- II. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 138 encoding the polypeptide of SEQ ID NO: 91, diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.
- III. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 139 encoding the polypeptide of SEQ ID NO: 92, diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.
- IV. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 146 encoding the polypeptide of SEQ ID NO: 99, diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.
- V. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 150 encoding the polypeptide of SEQ ID NO: 103, diagnostic

Art Unit: 1646

compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.

- VI. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 154 encoding the polypeptide of SEQ ID NO: 107, diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.
- VII. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 156 encoding the polypeptide of SEQ ID NO: 109, diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.
- VIII. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 157 encoding the polypeptide of SEQ ID NO: 110, diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.
- IX. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 167 encoding the polypeptide of SEQ ID NO: 120,

Art Unit: 1646

diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.

- X. Claims 1-8, 13, 14, 16 and 18, in so far as they are drawn to polynucleotide sequences of SEQ ID NO: 169 encoding the polypeptide of SEQ ID NO: 122, diagnostic compositions thereof, host cells, vectors, recombinant expression of such, antisense molecules and methods of diagnosing disease using such, classified in class 435, subclass 69.1, for example.

The inventions are distinct, each from the other because of the following reasons:

In section 803.04 of the MPEP, examples of typical nucleotide sequence claims impacted by the partial waiver of 37 CFR 1.141 et seq. (and the partial waiver of 37 CFR 1.475 and 1.499 et seq., see MPEP § 1850) include:

- (A) an isolated and purified DNA fragment comprising DNA having at least 95% identity to a DNA sequence selected from SEQ ID Nos. 1-1,000;
- (B) a combination of DNA fragments comprising SEQ ID Nos. 1-1,000; and
- (C) a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID Nos. 1-1,000.

The instant application differs from the above examples in that what is claimed is not limited to polynucleotides comprising specific DNA sequences selected from a group of SEQ ID Nos., but is defined by what it encodes, which is ten different proteins. The claims are not limited to a single

Art Unit: 1646

nucleotide sequence encoding each protein, but to any nucleic acid molecule encoding each of those proteins. Therefore, the partial waiver does not apply.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their separate search requirements and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 9-12, 15 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention.

Serial Number: 09/191,997

Page 7

Art Unit: 1646

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D

Eileen B. O'Hara 5/3/02

Patent Examiner

Lorraine Spector

LORRAINE SPECTOR
PRIMARY EXAMINER